Case AA374

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of	:	
H. K. TANAKA ET AL.	:	Confirmation No. 7253
Serial No.: 09/868,256	:	Group Art Unit: 1619
Filed: June 15, 2001	:	Examiner: Gina C. Yu

For : Transparent Skin Care Compositions

BRIEF ON APPEALS

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed, pursuant to 37 C.F.R. 1.192(a), is Appellant's brief on Appeal for the above application. The Brief is being forwarded in triplicate.

The fee for this Brief on Appeal is $330.00 37 CFR 1.17(c).

The Director is hereby authorized to charge the above fee, or any additional fees that may be required, or credit any overpayment to Deposit Account No. 16-2480 in the name of The Procter & Gamble Company. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

By Eileen L. Hughett
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Registered Patent Agent
Registration No. 34,352
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April 5, 2004

Customer No. 27752

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APPELLANT'S BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450
Dear Sir,

This is responsive to the Final Rejection Action mailed on September 10, 2003 in the above-captioned application, setting a two (2) month period from the date of the Notice of Appeal filed on January 10, 2004, for filing an Appellant's Brief. The time for response being extended by one month From March 8, 2004 to April 8, 2004, pursuant to the fee charged to the Assignee's Deposit Account in the papers submitted herewith. This Appellant's Brief is being filed in triplicate.

REAL PARTY IN INTEREST

This Application has been assigned to The Procter & Gamble Company of Cincinnati, Ohio. The Inventor(s), Hidekazu Tanaka, Kiyoaki Mori, and Shuichi Tsunetsugu, assigned their interest to the Procter & Gamble Company in an assignment corresponding to application Serial No. 09/868,256, filed June 15, 2001 (recorded on August 9, 2001, at reel number 12972, and frame number 669).

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences known to the Appellant, or known to Appellant's legal representative, that will directly affect the Board's decision in the present appeal.

STATUS OF CLAIMS

The application was originally filed with claims 1-10. Claim 3 has been canceled. Claims 1, 2 and 4-10 are pending and are finally rejected.

Appellant appeals the final rejection of September 10, 2003 (the Notice of Appeal for these claims was mailed on January 8, 2004 and received by the Office on January 8). A complete copy of the appealed claims is set forth in the Appendix.

STATUS OF AMENDMENTS

All amendments which have been submitted have been entered by the Examiner.

SUMMARY OF INVENTION

The application currently discloses and claims a transparent skin care composition comprising: surfactant combinations selected from two groups:

(a) from about 0.001 to about 5.0% of a surfactant combination comprising i), ii), and iii) wherein i) is a polyoxyethylene sorbit tetraalkyl ester, ii) is a polyoxyethylene castor oil ester and/or polyoxyethylene hydrogenated castor oil ester; and iii) is a polyoxyethylene alkyl phosphate or salts; or

(b) from about 0.001 to about 5.0% of two or more surfactants selected from the group consisting of polyoxyethylene sorbit tetraalkyl ester, polyoxyethylene castor oil ester and/or polyoxyethylene hydrogenated castor oil ester, polyoxyethylene alkyl phosphate or salts, and mixtures thereof.

One of the above surfactant combinations is combined with the following: from about 0.001 to about 5.0% of an oil compound; from about 0.01 to about 10% of a polyhydric alcohol; and from about 60 to about 99.8% of water; wherein the oil compound is substantially solubilized in the transparent skin care composition.

ISSUES

1. Whether Claims 1, 2 and 4-10 were properly rejected under 35 U.S.C. §103(a) as being unpatentable over the Sumida reference (Japanese HEI 4(1992)-48925) in view of Motono (US 49854555) or alternatively in view of Sugizaki (Japanese Kokai application 3-115208)?

2. Whether Claims 8-10 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over the Koyanagi et al reference (US 5474776) in view of Motono (US 49854555) or alternatively in view of Sugizaki (Japanese Kokai application 3-115208)?

GROUPING OF CLAIMS

The first statement of grounds of rejection is equally applicable to each claim. The second statement of grounds of rejection applies to Claims 8-10.

ARGUMENTS

1. Whether Claims 1, 2 and 4-10 were properly rejected under 35 U.S.C. §103(a) as being unpatentable over the Sumida reference (Japanese HEI 4(1992)-48925) in view of Motono (US 49854555) or alternatively in view of Sugizaki (Japanese Kokai application 3-115208)?

The Office Action asserts that the instant application is unpatentable over Sumida in view of Motono (US 4,985,455). Sumida discloses a transparent microemulsion made by pre-emulsification using high pressure equipment such as a microfluidizer. The citation states at Comparative Example 1 **"without the use of a microfluidizer, a microemulsion is not formed."**

Therefore, no motivation is provided to explore a combination of surfactants, which would solubilize the oil without the use of a microfluidizer.

On the other hand, the instant invention at page 4, lines 8-10 states: "...it is believed that the **combination of surfactants** significantly increases the oil solubilization" (emphasis mine). It is significant therefore that Sumida does not teach or imply using the POE tetraalkyl esters of the presently claimed composition. Sumida teaches mono, tri and penta alkyl esters including POE monooleates, monostearates, trioleates and pentaoleates, however, not tetra alkyl esters. One skilled in the art, noticing the conspicuous avoidance of tetra alkyl esters would actually be led away from applying them to the presently claimed compositions. Certainly, absent the teaching of the instant application, there is no motivation for selecting the three requisite surfactants from the numerous combinations possible.

In order to overcome the absence of the POE tetraalkyl esters, the Examiner asserts that Sumida should be viewed in light of Motono. Motono discloses external preparations comprising kojic acid, or a derivative thereof, the compositions also containing an ultraviolet absorber, ß-cyclodextrin and ethylenediaminetetraacetic acid. The cited compositions have a controlled pH in the range of from 4.0 to 5.0. One of the cited Examples includes the use of polyoxyethylene sorbitol tetraoleate. The preparation of the aqueous portion of the final composition is described and the aqueous solution is stated to be "clear". However, there is no statement that the final emulsion is clear.

The MPEP at Section 2143 states:

> "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally the prior art references must teach or suggest all the claim limitations."

Certainly, there is no motivation provided by Sumida to add the instant surfactant combination. In fact there is no motivation to change any component in order to remove the necessity to microfluidize. In addition, there is no reason to believe that any component used in Motono would result in a successfully solubilized product, including the polyoxyethylene sorbitol tetraoleate. If one were to pick and choose individual components (based on a reading of the instant disclosure) and then construct a claim which contained the elements of the instant invention, it would be the result of hindsight reconstruction. As the three requirements for obviousness are not met by the combination of citations, it is respectfully requested that the current obviousness rejection be withdrawn.

The claims are also rejected as obvious over Sumida in light of Sugizaki. Sugizaki discloses a water-in-oil composition having very low levels of water, 0.5% in all the examples shown in Table I, while the instant compositions comprise at least 60% water. One of skill in the art would understand that the behavior of such different compositions would not be the same. There would be no motivation for one of skill in the art to consider components of the Sugizaki reference with its high oil content for addition to the Sumida compositions with their much lower oil content and much higher water content. Therefore, based on the requirements given above, the cited combination does not render the instant invention obvious.

2. Whether Claims 8-10 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over the Koyanagi et al reference (US 5474776) in view of Motono (US 49854555) or alternatively in view of Sugizaki (Japanese Kokai application 3-115208)?

Claims 8-10 are rejected as being unpatentable over Koyanagi et al. in view of Motono.

Koyanagi discloses cleansing compositions comprising hydrophilic nonionic surfactants, an amphoteric surfactant, a water soluble compound containing at least one hydroxyl group, a liquid oil and water. The instant invention does not contemplate the addition of an amphoteric surfactant. The instant compositions contain nonionic surfactants and an anionic surfactant. Therefore one of skill in the art would not equate the compositions of Koyanagi with those of the instant invention, nor find motivation in Koyanagi to include an anionic. Additionally, the water content of Koyanagi's compositions and those of the instant invention varies considerably. The claimed compositions contain at least 60% water, and are thus clearly distinguished from Koyanagi's which contain from 1-40% water. Further, Tables 1, 2, and 3, of Koyanagi show that the preferred range is 5 to 15%, considerably below the minimum level of 60% in the instant compositions.

Koyanagi provides no motivation to select the specific surfactant combination which is now claimed. This is particularly evident given the fact that Koyanagi discloses that its composition is preferably (and not necessarily limited to) hydrophilic nonionic surfactants having an HLB value higher than 9. There are hundreds of surfactant classes and members of those classes, as is illustrated at column 2 and ending at column 4 of the citation. Only by using hindsight provided by a reading of the instant application, would one of skill in the art arrive at the specific claimed combinations. Such use of hindsight is impermissible.

To suggest that among all the non-ionic surfactants discussed by Koyanagi, an artisan is specifically taught the presently claimed combination (at the specific ratio) is highly speculative and unsubstantiated by the cited disclosure. The is particularly true since the compositions of Koyanagi are cleansing compositions, designed to be rinsed off the skin, while the instant compositions remain on the skin to provide moisturizing benefits.

As previously discussed Motono discloses external preparations comprising kojic acid, or a derivative thereof, which also contain an ultraviolet absorber, ß-cyclodextrin and ethylenediaminetetraacetic acid and have a controlled pH in the range of from 4.0 to 5.0. The

polyoxyethylene sorbitol tetraoleate used in Motono is one of three surfactants used in the example, which the Examiner has cited. If one of skill in the art were to decide, even without motivation to alter Koyanagi's compositions, to make an alteration, it would take a number of formulation changes to produce any composition, which would fall within the claims of the instant invention. There would be no motivation to choose Motono from the many patents related to skin care. Then, absent the hindsight provided by the instant application, there would be no motivation to chose the polyoxyethylene sorbitol tetraoleate, from among the components disclosed as suitable for use in that citation. The combination of Koyanagi and Motono does not render the instant invention obvious.

Further the Office Action asserts that the instant application is obvious in light of Koyanagi in view of Sugizaki. Sugizaki discloses a water-in-oil composition having very low levels of water, 0.5% in all the examples shown in Table 1, while, as previously noted, the instant compositions comprise at least 60% water. One of skill in the art would understand that the behavior of such different compositions would not be the same. There would be no motivation for one of skill in the art to consider components of the Sugizaki reference with its high oil content for addition to the Koyanagi compositions with their much lower oil content and much higher water content. Therefore, based on the requirements for obviousness given above, the cited combination does not render the instant invention obvious.

SUMMARY

In view of the above, Appellant respectfully submits that there is insufficient teaching by Sumida or Koyanagi combined with either Montono or Sugizaki to support a prima facie case of obviousness. Accordingly Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the obviousness rejection and remand with directions to allow all of the claims of the present application.

Respectfully submitted,

By Eileen L Hughett

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April 5, 2004

Customer No. 27752